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## FACSIMILE TRANSMITTAL to the U.S. Patent Office

DATE: April 4, 2003

TO: Tamthou Ngo Truong FAX NO.: 703-308-4734  
FROM: John B. Alexander, Ph.D. FAX NO.: 617-439-4170

Serial No. 09/811,369 Atty. Docket No. 49662 (72021)  
Filed On: March 16, 2001

Pages: 8 including cover

### MESSAGE:

Enclosed please find a copy of the Office Action, dated January 30, 2002, in connection with U.S. Serial No. 09/811,359.

Please contact me if you have any questions, or if I can be of any further assistance.

Best Regards,

John B. Alexander, Ph.D. (Reg. No 48,399)

### NOTICE

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## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,359	03/16/2001	Taeyoung Yoon	49662 [72021]	7721
7390 01/30/2002		<div> <div>EXAMINER</div> <div>TRUONG, TAM THOM NGO</div> </div>		
EDWARDS & ANGELL, LLP Dike, Bronstein, Roberts & Cushman Intellectual Property Patent Practice P.O. Box 9169 Boston, MA 02109		<div> <div>ART UNIT</div> <div>PAPER NUMBER</div> </div>		

1624

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

*Amendement*  
Edwards & Angell LLP  
Dike, Bronstein, Roberts & Cushman  
101 Federal St. Boston, MA 02110  
Date Rec'd. 2/4/02  
Docketed For Mar 30 - Jul 30, 2002  
By KSD  
Approved \_\_\_\_\_

**Office Action Summary**

Application No.

09/811,359

Applicant(s)

YOON ET AL.

Examiner

Tamthom N. Truong

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☒ Claim(s) 39-68 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

Claims 1-68 are pending.

#### *Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. The terms: "including", "containing" or "contain" render the above claims indefinite because they do not exclude the presence of other substituents that are not recited.
- b. The term "alkyl" is used to also mean 'alkenyl' and 'alkynyl' which is not acceptable in the art because the term "alkyl" suggests saturated carbon-carbon bonds only.
- c. Claims 14-17 lack antecedent basis because they recite variables  $R_x$  and  $R_y$  which are not in the specification.
- d. The term "stress-related disorder" is not clear as to which diseases it refers to. There appears to be no definition in the specification for said term.

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***Claim Rejections - 35 USC § 112, 1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 27, and 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not define the term "stress-related disorder", and does not provide any bioassay to show the activity of the claimed compounds for such disorder. Note, said term includes non-psychological disorders such as diabetes, cardiovascular, myocardial infarct, etc. None of said disorders were tested for in the specification. Thus, given the complicated nature of each disorder, one skilled in the art will have to carry out undue experimentation to apply the claimed compounds to all disorders related to stress.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in

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section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Murata et. al. (US 5,972,946). On column 29, Table 11 lists starting compounds # 22-30, which are embraced by the claimed formula with the following substituents:

- a. Ar is a substituted phenyl group;
- b.  $R_1$  and  $R_2$  are both alkyl groups -- note  $R_1$  corresponds to the reference's  $R_6$  while  $R_2$  corresponds to the reference's  $R_5$ .
- c.  $R_3$  represents a halogen.

Thus, at the time of the invention, one skilled in the art would have known how to make the claimed compounds.

#### *Claim Objections*

4. Claims 39-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. A search in the pertinent art area did not yield any reference teaching or suggesting species claimed in claims 39-68.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

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January 25, 2002

*Mukund Shah*  
SUPERVISOR  
RECEIVED  
JAN 25 2002

<b>Notice of References Cited</b>	Applicant/Control No. 09/811,359	Applicant(s)/Patent Under Reexamination YOON ET AL.	
	Examiner Tamthom N. Truong	Art Unit 1624	Page 1 of 1

## U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,972,946	10-1999	MURATA et. al.	
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

## FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

## NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.